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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,832	11/17/1999	CLEMENT LAWSON	2870/192	5091

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EXAMINER

BERMAN, ALYSIA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 04/01/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/441,832

Applicant(s)

LAWSON ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 20, 22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-19, 21, 23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Receipt is acknowledged of the response and associate power of attorney filed January 22, 2002. Claims 1-26 are pending. No claims have been amended. Claims 4-6, 20, 22 and 24 are withdrawn as being directed to a nonelected species of the invention in the amendment filed July 10, 2001, paper no 5.

Continued Prosecution Application

2. The request filed on January 22, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/441832 is acceptable and a CPA has been established. An action on the CPA follows.

Election/Restrictions

3. This application contains claims drawn to an invention nonelected with traverse in the amendment filed July 10, 2001, paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

5. Claims 1, 7, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The term "sterol-based" in the claims is vague and indefinite. This rejection is maintained for reasons of record in the Office Action dated February 5, 2001, paper no.

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3. Neither the specification nor the claims provide an exclusive definition of what is encompassed by sterol-based surfactant/emulsifier. The metes and bounds of the claims cannot be determined.

Claim Rejections - 35 USC § 102

7. The 35 U.S.C. 102(b) rejections of claims 1, 2, 7-11 and 14 over US 5,567,420 and US 5,747,049 are withdrawn because, although the references teach each and every element of the claims, they do not teach the elements arranged as in the claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 2, 7-11, 14-17, 21, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,567,420 (420).

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These rejections are maintained for reasons of record in paper no. 3. US '420 discloses a colored cosmetic composition in the form of a gel (abstract and claims 1 and 9). For polyhydric alcohols and water, see column 3, lines 38-40, column 5, line 58, Table 1 at column 9, and claim 9. For pigments such as titanium dioxide, talc and kaolin in an amount from about 2-25 wt.% and 1-10 wt.%, respectively, see column 5, lines 1-8 and claim 10. For sterols, see column 5, line 61. For fatty acid alkali metal salts and ethoxylated cholesterol as emulsifiers, see column 6, lines 25-54. For cholesterol, see column 8, line 4.

US '420 does not teach the amounts of components as instantly claimed in claims 15 and 16. It is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, absent evidence of unexpected results, the amounts of components are not given patentable weight over the prior art.

The intended use of a substance in a composition does not render the instantly claimed composition patentable over the prior art composition containing that substance for a different use. See *In re Tuominen*, 213 USPQ 89, *In re Spada* 15 USPQ 1655, MPEP §2112.01 and *In re Pearson*, 181 USPQ 641. A substance contained in a composition containing the same components as instantly claimed would be expected to exhibit the same properties absent evidence to the contrary. Therefore, no criticality is given to the limitation that the sterol-based component is a surfactant/emulsifier.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '420 and select optimal amounts of

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components with the expectation of obtaining a composition that provides moisturizing benefits to the skin.

11. Claims 1, 2, 7-11, 14-17, 21, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,747,049 (049).

This rejection is maintained for reasons of record in paper no. 3. US '049 discloses a cosmetic composition comprising titanium dioxide, talc, kaolin and zinc oxide (col. 5, lines 41-43). For additional pigments, see column 10, line 58 to column 11, line 17. For polyhydric alcohols, see column 6, lines 22-28. For cholesterol derivatives and phytosterols, see column 6, lines 48-51, column 8, lines 6, 19-20 and 26. For fatty acid alkali metal salts, see column 8, lines 49-50.

US '049 does not teach the amounts of components as instantly claimed in claims 15 and 16. It is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, absent evidence of unexpected results, the amounts of components are not given patentable weight over the prior art.

The intended use of a substance in a composition does not render the instantly claimed composition patentable over the prior art composition containing that substance for a different use. See *In re Tuominen*, 213 USPQ 89, *In re Spada* 15 USPQ 1655, MPEP §2112.01 and *In re Pearson*, 181 USPQ 641. A substance contained in a composition containing the same components as instantly claimed would be expected to exhibit the same properties absent evidence to the contrary. Therefore, no criticality is given to the limitation that the sterol-based component is a surfactant/emulsifier.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 and select optimal amounts of components with the expectation of obtaining a composition that provides moisturizing benefits to the skin.

12. Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 each as applied to claims 1, 2, 7-11, 14-17, 21, 23 and 25 above, and further in view of US 5,242,070 (070).

This rejection is maintained for reasons of record in paper no. 3. US '420 and US '049 teach all the limitations of the claims as stated above. They do not teach sodium behenate or potassium behenate.

US '070 teaches the equivalence of soaps of fatty acids such as sodium salts of fatty acids having 12 to 22 carbon atoms at column 6, lines 40-60. For sodium behenate and sodium stearate, see column 6, lines 61-68. It is *prima facie* obvious to one of ordinary skill in the art to substitute the claimed fatty acid salt in the composition of either US '420 or US '049 and expect similar properties. In the absence of unexpected results, the substitution of one known fatty acid salt for another would have been an obvious modification for one of ordinary skill in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 each and substitute sodium behenate for the fatty acid ester alkali metal salt as taught by US '070 with the expectation of obtaining a composition that provides moisturizing benefits to the skin.

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13. Claims 12, 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 each as applied to claims 1, 2, 7-11, 14-17, 21, 23 and 25 above, and further in view of US 5,741,499 (499).

This rejection is maintained for reasons of record in paper no. 3. US '420 and US '049 teach all the limitations of the claims as stated above. They do not teach isoprene glycol or pigment coated with dimethicone. US '499 teaches topical mousse compositions that comprise isoprene glycol (col. 7, line 2) and pigments that may be coated with silicone compounds (col. 8, line 66 to col. 9, line 15).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 substituting isoprene glycol and silicone coated pigments as taught by US '499 with the expectation of providing a composition with moisturizing benefits and good color.

14. Claims 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 as applied to claims 1, 2, 7-11, 14-17, 21, 23 and 25 above, and further in view of US 5,393,526 (526).

This rejection is maintained for reasons of record. US '420 and US '049 teach all the limitations of the claims as stated above. They do not teach dimethicone-coated pigments. US '526 teaches that colored cosmetic compositions generally require pigments of which dimethicone coated titanium dioxide is preferred (col. 2, lines 53-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 substituting

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dimethicone coated pigments as taught by US '526 with the expectation of providing a cosmetic composition with good color.

Response to Arguments

15. Applicant's arguments filed January 22, 2002 have been fully considered but they are not persuasive.

16. All of Applicants' arguments have been previously presented and addressed in the Final Office Action dated August 21, 2001, paper no. 7, and the Advisory Action dated December 18, 2001, paper no. 9.

17. Applicant argues that sterol-based surfactants are described at page 4 of the specification and one of ordinary skill in the art understands what sterol-based means. However, a fair review of the specification at page 4 did not turn up an exclusive definition of sterol-based surfactants. In fact, the definition at page 4 actually lends to the indefiniteness of the term because it recites derivatives but does not further define the derivatives. Therefore, it is unclear what is included and excluded from the term sterol-based and the metes and bounds of the claims cannot be determined.

18. Applicant argues that US '420 fails to disclose a non-emulsion gel as instantly claimed. Although emulsions are disclosed as a preferred embodiment in the '420 patent, the patent is not exclusively limited to emulsions. All disclosures in a reference patent must be evaluated, including non-preferred embodiments. A reference is not limited to disclosure of the specific working examples. See *In re Mills* 176 USPQ 196 (CCPA 1972). Disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it

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is unsatisfactory for the intended purpose. See *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). US '420 discloses that the compositions may be in various forms including gels (col. 3, lines 36-38 and claim 1). It is known in the art that gels are not conventionally in the form of emulsions. Additionally, US '420 makes a clear distinction between gels and emulsions at column 9, line 65 to column 10, line 12 and claim 1. Therefore, one of ordinary skill in the art would understand from the teachings of US '420 that the compositions may be in the form of emulsions or gels.

19. Applicant argues that US '070 does not teach the equivalence of sodium stearate and sodium behenate. US '070 clearly teaches at column 6, lines 41-60 that soaps of saturated and unsaturated fatty acids having from 12-22 carbon atoms are useful as a gel-forming agent. In the abstract and throughout the specification, for example at column 6, lines 41-44, the references refers to a soap and a gel-forming agent, which implies the use of one. The composition containing a mixture of fatty acid soaps as disclosed by US '070 is a preferred embodiment and does not limit the reference to only a mixture of fatty acid soaps. All disclosures in a reference patent must be evaluated, including non-preferred embodiments. A reference is not limited to disclosure of the specific working examples. See *In re Mills* 176 USPQ 196 (CCPA 1972). Disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. See *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Further, the claims do not exclude additional components such as additional fatty acid soaps. Therefore, one of ordinary skill in the art would be motivated to use sodium behenate

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alone or in combination with other fatty acid soaps as disclosed by US '070 in the compositions of either US '420 or US '049 for their gel-forming properties.

20. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, substituting sodium behenate as taught by US '070 for sodium stearate in either US '420 or US '049 is motivated by the disclosure in US '070 that these two compounds are equivalent and one would expect similar results.

Conclusion

21. This is a CPA of applicant's earlier Application No. 09/441832. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

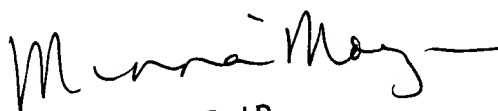
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
March 26, 2002


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